

REMARKS

The present application includes pending claims 1-20, all of which remain rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,163,817 (“Shteyn”). Claims 4, 9, 12, 15, and 18-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shteyn in view of United States Patent No. 5,871,397 (“Miguel”). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and the following:

I. **Shteyn Does Not Render Claims 1-3, 5-8, 10, 11, 13, 14, 16, And 17 Unpatentable**

The Applicants first turn to the rejection of claims 1-3, 5-8, 10, 11, 13, 14, 16, and 17 as being unpatentable over Shteyn. In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must **both be found in the prior art, and not based on applicant's disclosure**.

See Manual of Patent Examining Procedure (MPEP) at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

The law is well settled that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

Additionally, if a *prima facie* case of obviousness is not established, an applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See Manual of Patent Examining Procedure MPEP at § 2142.

A. Shteyn Does Not Teach Or Suggest A Game Subsystem

Shteyn discloses an “information processing system [having] first and second electronic sub-systems, and control means for controlling the sub-systems.” Shteyn at Abstract. Shteyn lists examples of the sub-systems:

In a home theater environment, sub-systems 102-106 each comprise, for example, any of a one or more display devices, one or more VCR’s, one or more TV tuners, one or more radio tuners, one or more audio amplifiers, one or more a (sic) DVD players, a CD jukebox, a digital video camera, a home security system, etc. Alternatively, sub-systems 102-106 each comprise a respective cluster of such pieces of equipment, e.g., organized according to the

location of these devices, such as the associated room or building.

Shteyn at column 4, lines 4-12. Notably, neither this passage, nor the remainder, of Shteyn teaches or suggests a game subsystem.

The Office Action acknowledges as much by stating “Shteyn does not explicitly disclose a game subsystem.” *See April 20, 2006 Office Action at page 2.* In order to overcome this deficiency, however, the Office Action states that “Shteyn teaches that **any** electronic subsystem, including a jukebox or **any** software application can be coupled to a control subsystem (column 2, lines (sic) 34, column 4, line 67).” *See id.* at pages 2-3.

The portion relied on in the Office Action, however, does not teach or suggest that **any** electronic subsystem can be used, and certainly does not teach or suggest a game subsystem. For example, Shteyn discloses the following:

[T]he invention provides an information processing system that comprises first and second electronic sub-systems and control means for controlling at least the first sub-system. At least the first sub-system has a software representation registered with the control means.

Shteyn at column 2, lines 32-36. There is nothing in this passage that teaches or suggests that the electronic sub-system can be **any** electronic sub-system. Moreover, as the Office Action acknowledges, “Shteyn does not explicitly disclose a game subsystem.” *See April 20, 2006 Office Action at page 2.*

Additionally, Shteyn discloses the following:

FIG 1 is a block diagram of an information processing system 100 in the invention. System 100 comprises a first electronic sub-system 102, a second electronic sub-system 104, a third electronic sub-system 106 and control means 108.

Shteyn at column 3, lines 25-29. Again, however, there is nothing in this passage of Shteyn that teaches or suggests that the sub-systems 102, 104, and 106 can be **any** electronic sub-system.

Shteyn does list numerous types of subsystems, as noted above. In particular, Shteyn lists VCR's, TV tuners, radio tuners, DVD players, and the like. *See* Shteyn at column 4, lines 4-12. Shteyn never states, however, that the sub-systems can be **any** electronic sub-system. Moreover, Shteyn never discloses a game subsystem.

As detailed above, Shteyn does not teach or suggest a game subsystem as recited in claims 1, and 18. Additionally, Shteyn does not teach or suggest providing "game functionality," as recited in claims 1, 11, and 18. At least for these reasons, Shteyn, by itself or in combination with Miguel, does not render the pending claims unpatentable.

B. Shteyn Does Not Inherently Disclose A Game Subsystem

As noted above, the Office Action states that "Shteyn does not **explicitly** disclose a game subsystem." *See* April 20, 2006 Office Action at page 2. Thus, the Office Action seemingly concludes that Shteyn inherently discloses a game subsystem.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *See* *See* Manual of Patent Examining Procedure at § 2112, *citing In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain

thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). The Applicants respectfully submit that neither Shteyn itself, nor the Office Action “make[s] clear that the missing descriptive matter,” assumed to be inherent (i.e., the game subsystem), “is necessarily present in” Shteyn.

II. The Proposed Combination Of Shteyn And Miguel Does Not Render Claims 4, 9, 12, 15, And 18-20 Unpatentable

The Office Action attempts to combine Miguel with Shteyn to reject claims 4, 9, 12, and 15 by stating the following:

It would have been obvious for one of ordinary skill in the art at the time of applicant’s invention to incorporate Miguel’s electronic dart game functionality as an electronic subsystem as disclosed in Shteyn, in order to minimize the overall number of system components necessary to provide entertainment.

See Office Action at page 5. The Office Action uses the same rationale to reject claims 18-20.

The Office Action merely relies on convenient assumptions concerning the knowledge or skill of one of ordinary skill in the art, rather than pointing to some evidence of that knowledge or skill. Though the Office Action speculates that one might obtain a proposed benefit from the proposed combinations (“minimizing the overall number of system components”), the Office Action does not point to anything in these references related to this benefit.

The Federal Circuit requires that the “factual inquiry whether to combine references must be thorough and searching.” *See, e.g., McGinley v. Franklin Sports, Inc.* 262 F.3d

1339, 1351-52 (Fed. Cir. 2001). “It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.” *See In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

Federal Circuit “case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczaik*, 175 F.3d 994, 999 (Fed. Cir. 1999). The “examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some **objective** teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching reference.’” *See in re Lee* , 277 F. 3d at 1343, citing *In re Fitch*, 972 F. 2d 1260, 1265 (Fed. Cir. 1992) (emphasis added).

The Applicants respectfully submit that the Office Action has not offered any **objective** teaching to support the conclusion that Miguel may be combined with Shteyn. Instead, the Office Action offers only subjective opinion as support.

In *In re Lee*, the Federal Circuit noted that the “Board rejected the need for ‘any specific hint or suggestion in a particular reference’ to support the combination of ... references,” which was an “[o]mission of a relevant factor required by precedent” that was both “**legal error and arbitrary agency action.**” *See id.* at 1344, citing *Morot Vehicle Manufacturers Ass’n v. State Farm Mutual Automobile Ins. Co.*, 463 U.S. 29 at 43 (1983) (emphasis added). In the present application, the Office Action has not specified any hint or suggestion in the cited references to support the proposed combination of Shteyn and Miguel. As the court in *In re Lee* stated:

[The Federal Circuit] explained ... that “deficiencies of the cited references cannot be remedied by the Board’s **general conclusions about what is ‘basic knowledge’ or ‘common sense.’**” The Board’s findings must extend to all material facts and must be documented in the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency’s expertise, **do not substitute for authority when the law requires authority.**”

See id. at 1344-1345 (internal citations omitted). Subjective opinion of “common knowledge” or “common sense” regarding a motivation to combine is not enough to establish a *prima facie* case of obviousness. The Applicants respectfully submit that the motivation to combine Shteyn with Miguel is based on subjective knowledge and convenient assumptions gleaned from Applicants’ disclosure, instead of the references themselves (as is required by Federal Circuit case law). Thus, at least for these reasons, the Applicants respectfully submit that the proposed combination of Shteyn and Miguel is improper.

III. Incorporating A Game Subsystem And Jukebox Subsystem Into A Single Unit Is Not Merely A Matter Of Engineering Design Choice

The Applicants next turn to the rejection of claims 18-20. Initially, the Applicants note that these claims should be in condition for allowance, at least for the reasons discussed above.

The proposed combination of Shteyn and Miguel does not teach or suggest a game subsystem and a jukebox subsystem within a single unit, as recited in claims 18-20. The Office Action, however, asserts that “it has been well settled that by providing a single unit or housing for making integral structures disclosed in the prior art would be

merely a matter of obvious engineering choice.” *See* April 20, 2006 Office Action at pages 5-6.

Claim 18 recites a “single unit” that houses the game subsystem, the jukebox subsystem, and the control subsystem. The Applicant respectfully submits that housing the game subsystem and the jukebox subsystem in a single unit is not merely a matter of obvious design choice. First, such game systems and jukebox systems are not normally linked to one another.

Next, the background of the present application clearly discusses the disadvantages of numerous game machines having separate housings. Overall, there has been a need for maximizing the floor space within an establishment, and to reduce the number of operational gaming systems in an establishment, as described in the background section of the present application. *See, e.g.*, present application at ¶¶ [0005 – 0006] (“Electronic entertainment devices and jukeboxes, however, **occupy valuable floor space** that could otherwise be profitably used, for example, for additional customer seating.... **Reducing the number of operational gaming systems in an entertainment establishment may in many instances reduce overall operating expenses**”). Housing a gaming system and a jukebox system into a single unit addresses these needs, and should therefore be patentable. *See Shenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed.Cir. 1983).

The cases on which the Office Action relies, *In re Larson* and *In re Wolfe*, are inapplicable to the Applicants’ claims. In *In re Larson*, the court rejected a claim to a one-piece handle for a massage device because the prior art disclosed a handle for a massage device that was the same except that the prior art handle consisted of two pieces

fastened together. *See In re Larson*, 144 USPQ 347 (C.C.P.A. 1965) (holding “merely making a two-piece handle in one piece is not patentable invention because it is an obvious thing to do if deemed desireable”). In *In re Wolfe*, the court rejected a claim to a “brake drum integral with a said clamping means” because “the term ‘integral’ is not limited to a fabrication of the parts from a single piece of metal, but is inclusive of other means for maintaining the parts fixed together as a single unit.” *See In re Wolfe*, 116 USPQ 443 (C.C.P.A. 1958) (“While the brake disc and clamp of [the prior art] comprise several parts, they are rigidly secured together as a single unit. The constituent parts are so combined as to constitute a unitary whole.)

Claims 18-20 are not directed to components fabricated from a single piece of material that have been previously joined to one another through some other means. Claims 18-20 are directed to a single unit that comprises a game subsystem, a jukebox subsystem, and a single control subsystem, which have never before been contained within a single unit. In other words, the term “single unit,” is not directed to the manner in which the components of the single unit are fastened or connected to one another. Rather, the term “single unit” is directed to the very idea of bringing the components together in the first instance. Thus, neither *In re Larson* nor *In re Wolfe*, are applicable to claims 18-20. Thus, at least for these reasons, claims 18-20 should be in condition for allowance.

V. Conclusion

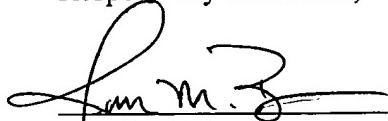
The Applicants respectfully submit that claims 1-20 of the present application should be in condition for allowance at least for the reasons discussed above and request reconsideration of the claim rejections. If the Examiner has any questions or the

Response Under 37 C.F.R. 1.111
Serial No.: 10/073,486
May 26, 2006

Docket No. 13267US02

Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney. The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,



Joseph M. Butscher
Registration No. 48,326
Attorney for Applicants

Date: May 26, 2006

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312)775-8100